



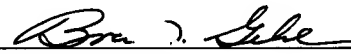
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application Serial No: 09/520,760
Date Filed: March 7, 2000
Application Title: Non-Nucleic Acid Probes, Probe Sets, Method and Kits
Pertaining To The Detection Of Human Chromosomes X,
2, 3, 6, 10, 11, 12, 16, 17, and 18
Applicants: Krishan L. Taneja
Group Art Unit: 1655
Examiner: Jehanne E. Souaya
Action Date: September 21, 2001
Action Type: Restriction/Election Requirement
Certified Mail No.: 7099 3400 0007 5728 5729

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Brian D. Gildea
Reg. No. 39,995

Commissioner for Patents
Washington, DC 20231

Dear Sir or Madam:

A petition for an automatic three-month extension of time has been included with the papers accompanying this document so please consider the following response to the Office Action mailed on September 21, 2001.

I. ACTION SUMMARY

Claims 1, 2, 10-12, 29, 31, 33, 34, 38, 39, 40, 45, 47, 49, 50, 54-56, 64-66 and 78-81 stand pending in this application. The Examiner has argued that claims 1-2, 10-12, 39-40, 54-56, 64-66 and 78-81 are subject to a restriction/election requirement.

II. FORMALITIES

1. It is noted that the present Office Action appears to indicate that claims 38 and 78-81 are not pending. Applicant notes for the record that these claims have not been canceled and therefore takes the position that claims 38 and 78-81 remain pending at this time.
2. Applicant takes note of the "Notice Of Draftperson's Patent Drawing Review" that was included with the present Office Action. Applicants have included with the papers accompanying this response, two additional copies of the formal color drawings as well as a petition under 37 C.F.R. §1.84(a)(2) and (b)(2) and fee set forth in 37 C.F.R. § 1.17(h). Accordingly, it is believed that this action addresses the objection to the drawings as raised by the Draftsperson. The additional color drawings are identical to those submitted with the application papers. No new matter has been added.

III. AMENDMENT

(i) *In the specification:*

In accordance with M.P.E.P. § 608.02, please insert the following text on page 13 after the Brief Description Of The Drawings:

? B2
-- The patent or application file contains at least one drawing executed in color. Copies of this patent or patent application publication with color drawing(s) will be provided by the U.S. Patent and Trademark Office upon request and payment of the necessary fee. --

(ii) *In the claims:*

Please amend the claims as follows. A clean (unmarked) set of claims is included as an Appendix to this Office Action response. The amendments set forth below are made to eliminate periods in the body of the claims that are otherwise statutorily objectionable.

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-- 38. (Once Amended) A method for detecting, identifying or quantitating one or more of human chromosomes Y, 1, 2, 3, 6, 8, 10, 11, 12, 16, 17 or 18 in a sample, said method comprising:

- a[.] contacting the sample with one or more non-nucleic acid probes having a probing nucleobase sequence which is specific for one or more of human chromosomes Y, 1, 2, 3, 6, 8, 10, 11, 12, 16, 17 or 18; and
- b[.] detecting, identify or quantitating hybridization of the probing nucleobase sequence of non-nucleic acid probes to the target sequences

of the chromosomes, and correlating the result with the presence, absence or number of the chromosomes in the sample.

40. (Once Amended) A method for detecting, identifying or quantitating one or more of human chromosomes X, Y, 1, 2, 3, 6, 8, 10, 11, 12, 16, 17 or 18 in a sample, said method comprising:

a[.] contacting the sample with one or more non-nucleic acid probes having a probing nucleobase sequence at least a portion of which is, at least ninety percent homologous to the nucleobase sequences, or their complements, selected from the group consisting of: CTT-CAA-AGA-GGT-CCA-CGA (Seq. ID No. 1); AGG-GTT-CAA-CTG-TGT-GAC (Seq. ID No. 2); GAA-ACT-TCT-GAG-TGA-TGA (Seq. ID No. 3); CAG-TCA-TCG-CAG-AAA-ACT (Seq. ID No. 4); AGA-TTT-CAC-TGG-AAA-CGG (Seq. ID No. 5); GTT-ATG-GGA-AGG-TGA-TCC (Seq. ID No. 6); TCG-AGC-CGC-AGA-GTT-TAA (Seq. ID No. 7); CTA-TTT-AGC-GGG-CTT-GGA (Seq. ID No. 8); TAC-AAG-GGT-GTT-GCA-AAC (Seq. ID No. 9); CCA-TAT-GCA-GTT-ATA-AGT-AGG (Seq. ID No. 10); TAT-TGT-ACC-AAG-CAG-AGT-ACC (Seq. ID No. 11); GGT-ATA-TAT-AAG-ATG-ACA-CAG-GA (Seq. ID No. 12); GTT-AGT-TAT-ATT-GGG-TGA-TAT-GT (Seq. ID No. 13); TCA-CAT-AAT-AGA-CAA-CAT-AC (Seq. ID No. 14); CAG-AAG-AGA-TTG-AAC-CTT (Seq. ID No. 15); GGC-ATA-GCA-CAT-AAC-ATG (Seq. ID No. 16); AAT-CGT-CAT-CGA-ATG-AAT (Seq. ID No. 17); CAT-TGA-ACA-GAA-TTG-AAT (Seq. ID No. 18); GTT-TTC-AGG-GGA-AGA-TAT (Seq. ID No. 19); TGT-GCG-CCC-TCA-ACT-AAC (Seq. ID No. 20); GAA-GCT-TCA-TTG-GGA-TGT (Seq. ID No. 21); CCA-ATA-AAA-GCT-ACA-TAG-A (Seq. ID No. 22); GAA-AAA-GTT-TCT-GAC-ATT-GC (Seq. ID No. 23); TAG-TTG-AAG-GGC-ACA-TCA (Seq. ID No. 24); CAC-AAA-TAA-GAT-TCT-AAG-AAT (Seq. ID No. 25); TCA-AAA-GAA-TGC-TTC-AAC-AC (Seq. ID No. 26); ATA-ATT-AGA-CCG-GAA-TCA-T (Seq. ID No. 27); GCT-GTT-TTC-TAA-AGG-AAA-G (Seq. ID No. 28); AAG-ACT-TCA-AAG-AGG-TCC (Seq. ID No. 29); TTT-GTC-AAG-AAT-TAT-AAG-AAG (Seq. ID No. 30); CAA-GAT-TGC-TTT-TAA-TGG (Seq. ID No. 31); TGT-GTA-TCA-ACT-CAC-GGA (Seq. ID No. 32); CCT-CAC-AAA-GTA-GAA-ACT

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(Seq. ID No. 33); GAA-AAA-GCA-GTT-ACT-GAG (Seq. ID No. 34); TAA-TAA-TTA-GAC-GGA-ATC-AT (Seq. ID No. 35); TTA-CAG-GGC-ATT-GAA-GCC (Seq. ID No. 36); CAG-TTA-TGA-AGC-AGT-CTC (Seq. ID No. 37); CAC-ACC-AGA-AAA-AGC-AGT (Seq. ID No. 38); AAG-GGT-AAA-CAC-TGT-GAG (Seq. ID No. 39); AGA-CAA-CGA-AAT-ATC-TTC-ATG (Seq. ID No. 40); CTA-GCA-GTA-TGA-GGT-CAA (Seq. ID No. 41); GCA-GAC-TTC-AGA-AAC-AGA (Seq. ID No. 42); GGC-CTC-AAA-GAC-GTT-TAA (Seq. ID No. 43); GTG-AAA-GTT-CCA-AGT-GAA (Seq. ID No. 44); GAG-TGC-TTT-GAA-GCC-TAC (Seq. ID No. 45); GAA-ACA-GCA-GAG-TTG-AAA (Seq. ID No. 46); TGC-AGA-GAT-CAC-AAC-GTG (Seq. ID No. 47); ACA-AAG-AAT-CAT-TCG-CAG (Seq. ID No. 48); AGT-GTT-AGA-AAA-CTG-CTC (Seq. ID No. 49); CTG-TTC-AGA-GTA-ACA-TGA (Seq. ID No. 50); CCG-CTT-GGA-AAT-ACT-ACA (Seq. ID No. 51); GAA-ATG-GAA-ATA-TCT-CCC-C (Seq. ID No. 52); TCT-AGG-AGG-TCC-AAT-TAT (Seq. ID No. 53); GAA-TTC-CCA-AGT-GGA-TAT (Seq. ID No. 54); CTG-TAG-GTT-TAG-ATG-AAG (Seq. ID No. 55); AAG-GAG-TGT-TTC-CCA-ACT (Seq. ID No. 56); GGC-TTC-AAG-GCG-CTC-TAA (Seq. ID No. 57); GCA-GAG-ACT-TCA-AAG-TGC (Seq. ID No. 58); CAC-ACA-CAC-GGT-GGA-CCA (Seq. ID No. 59); CAA-AGG-GAA-TGT-TCC-ATT (Seq. ID No. 60); CAC-ATA-GCA-GTG-TTT-GAG (Seq. ID No. 61); CTC-AAG-GCG-GTC-CAA-TTA (Seq. ID No. 62); GAG-TCG-AAA-TGC-ACA-CAT (Seq. ID No. 63); TAC-CAA-GAG-GAA-TGT-TGC (Seq. ID No. 64); ACG-GGA-TGC-AAT-ATA-AAA (Seq. ID No. 65); TGA-AGA-TTC-TGC-ATA-CGG (Seq. ID No. 66); AAG-GTT-TGT-ACT-GAC-AGA (Seq. ID No. 67); CTG-AAC-TAT-GGT-GAA-AAA (Seq. ID No. 68); ACT-AAC-TGT-GCT-GAA-CAT (Seq. ID No. 69); CCC-ATG-AAT-GCG-AGA-TAG (Seq. ID No. 70); AAC-TGA-ACG-CAC-AGA-TGA (Seq. ID No. 71); GGC-TAA-TCT-TTG-AAA-TTG-AAA (Seq. ID No. 72); AGG-TGG-ATA-ATT-GGC-CCT (Seq. ID No. 73); TGA-AGT-CCA-AAA-AAG-CAC (Seq. ID No. 74); CTT-AGA-CAT-GGA-AAT-ATC (Seq. ID No. 75); AAG-GGG-TCT-AAC-TAA-TCA (Seq. ID No. 76); GTA-GTT-GTT-GAG-AAT-GAT (Seq. ID No. 77); AAC-TTC-CCA-GAA-CTA-CAC (Seq. ID No. 78); ATT-CTT-GAA-ATG-GAA-CAC (Seq. ID No. 79);

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CTG-TGA-TTG-CTG-ATT-TGG (Seq. ID No. 80); GTC-ATC-ACA-GGA-AAC-ATT (Seq. ID No. 81); GAA-ATT-TCC-TGT-TGA-CAG-A (Seq. ID No. 82); GTT-TGA-AAG-CTG-AAC-TAT-G (Seq. ID No. 83); TCC-TGT-AAT-GTT-CGA-CAG (Seq. ID No. 84); TCA-TAG-AAC-GCT-AGA-AAG (Seq. ID No. 85); ACC-TTT-CTT-TTG-ATG-AAG-GA (Seq. ID No. 86); CAA-ATA-TCA-CAA-AAA-GAG-GG (Seq. ID No. 87); GAG-TTG-AAT-AGA-GGC-AAC (Seq. ID No. 88); GGC-CAA-ATG-TAG-AAA-AGG (Seq. ID No. 89); GCG-TTC-AAC-TCA-AGG-TGT (Seq. ID No. 90); TGT-CCT-TTA-GAC-AGA-GCA (Seq. ID No. 91); TGA-GAC-CAA-ATG-TAC-AAA-AG (Seq. ID No. 92); GAA-TAC-TGA-GTA-AGT-TCT-TTG (Seq. ID No. 93); AAC-TGC-ACA-AAT-AGG-GTG (Seq. ID No. 94); TGG-AGA-CAC-TGT-GTT-TGT (Seq. ID No. 95); CCA-GTT-GGA-GAT-TTC-AAT (Seq. ID No. 96); GAA-GCC-TGC-CAG-TGG-ATA (Seq. ID No. 97); TAC-AGC-ATT-CTG-GAA-ACC (Seq. ID No. 98); CCA-GAC-ACT-GCG-TAG-TGA (Seq. ID No. 99); ATA-TAA-TGC-TAG-AGG-GAG (Seq. ID No. 100); AAA-AAC-AAG-ACA-AAC-TCG (Seq. ID No. 101); ATT-TCA-GCT-GAC-TAA-ACA (Seq. ID No. 102); AAC-GAA-TTA-TGG-TCA-CAT (Seq. ID No. 103); GGT-GAC-GAC-TGA-GTT-TAA (Seq. ID No. 104); TTT-GGA-CCA-CTC-TGT-GGC (Seq. ID No. 105); AAC-GGG-ATA-ACT-GCA-CCT (Seq. ID No. 106); TTT-GTG-GTT-TGT-GGT-GGA (Seq. ID No. 107); AGG-GAA-TAG-CTT-CAT-AGA (Seq. ID No. 108); ATC-ACG-AAG-AAG-GTT-CTG (Seq. ID No. 109); CCG-AAG-ATG-TCT-TTG-GAA (Seq. ID No. 110); AAA-GAG-GTC-TAC-ATG-TCC (Seq. ID No. 111); TTC-CCG-TAA-CAA-CTA-TGC (Seq. ID No. 112); TCC-CGT-AAC-AAC-TAG-GCA (Seq. ID No. 113); AAA-AGG-AGT-GAT-CCA-ACC (Seq. ID No. 114); TCC-CTT-TGG-TAG-AGC-AGG (Seq. ID No. 115); ATT-TGA-GAT-GTG-TGT-ACT-CA (Seq. ID No. 116) ; GCA-CTT-ACC-GGC-CTA-AG (Seq. ID No. 117) and CTC-AGA-AAC-TTA-CTC-GTG (Seq. ID No. 118); and

- b[.]) detecting, identify or quantitating hybridization of the probing nucleobase sequence of non-nucleic acid probes to the target sequences of the chromosomes, and correlating the result with the presence, absence or number of the chromosomes in the sample.

45. (Once Amended) The method of claim 40, wherein the presence, absence or number of human chromosome 3 is determined by:

- B4
- a[.] contacting the sample with one or more non-nucleic acid probes, wherein at least one probe has a probing nucleobase sequence, at least a portion of which is at least ninety percent homologous to the nucleobase sequences, or their complements, selected from the group consisting of:
ATA-ATT-AGA-CCG-GAA-TCA-T (Seq. ID No. 27); GCT-GTT-TTC-TAA-AGG-AAA-G (Seq. ID No. 28); AAG-ACT-TCA-AAG-AGG-TCC (Seq. ID No. 29); TTT-GTC-AAG-AAT-TAT-AAG-AAG (Seq. ID No. 30); CAA-GAT-TGC-TTT-TAA-TGG (Seq. ID No. 31); TGT-GTA-TCA-ACT-CAC-GGA (Seq. ID No. 32); CCT-CAC-AAA-GTA-GAA-ACT (Seq. ID No. 33); GAA-AAA-GCA-GTT-ACT-GAG (Seq. ID No. 34); TAA-TAA-TTA-GAC-GGA-ATC-AT (Seq. ID No. 35); TTA-CAG-GGC-ATT-GAA-GCC (Seq. ID No. 36); CAG-TTA-TGA-AGC-AGT-CTC (Seq. ID No. 37); CAC-ACC-AGA-AAA-AGC-AGT (Seq. ID No. 38); AAG-GGT-AAA-CAC-TGT-GAG (Seq. ID No. 39); AGA-CAA-CGA-AAT-ATC-TTC-ATG (Seq. ID No. 40); CTA-GCA-GTA-TGA-GGT-CAA (Seq. ID No. 41); GCA-GAC-TTC-AGA-AAC-AGA (Seq. ID No. 42); GGC-CTC-AAA-GAC-GTT-TAA (Seq. ID No. 43); GTG-AAA-GTT-CCA-AGT-GAA (Seq. ID No. 44); GAG-TGC-TTT-GAA-GCC-TAC (Seq. ID No. 45); GAA-ACA-GCA-GAG-TTG-AAA (Seq. ID No. 46); TGC-AGA-GAT-CAC-AAC-GTG (Seq. ID No. 47); ACA-AAG-AAT-CAT-TCG-CAG (Seq. ID No. 48); and AGT-GTT-AGA-AAA-CTG-CTC (Seq. ID No. 49); and

- b[.] detecting, identifying or quantitating hybridization of the probing nucleobase sequence of the probe to a target sequence in the sample to thereby correlate the result with the presence, absence or number of human chromosome 3 in the sample.

47. (Once Amended) The method of claim 40, wherein the presence, absence or number of human chromosome 8 is determined by:

- B5
- a[.] contacting the sample with one or more non-nucleic acid probes, wherein at least one probe has a probing nucleobase sequence, at least a portion of which is at least ninety percent homologous to the nucleobase sequences, or their complements, selected from the group consisting of:

ACG-GGA-TGC-AAT-ATA-AAA (Seq. ID No. 65); TGA-AGA-TTC-TGC-ATA-CGG (Seq. ID No. 66); AAG-GTT-TGT-ACT-GAC-AGA (Seq. ID No. 67); CTG-AAC-TAT-GGT-GAA-AAA (Seq. ID No. 68); ACT-AAC-TGT-GCT-GAA-CAT (Seq. ID No. 69) and CCC-ATG-AAT-GCG-AGA-TAG (Seq. ID No. 70); and

b[.] detecting, identifying or quantitating hybridization of the probing nucleobase sequence of the probe to a target sequence in the sample to thereby correlate the result with the presence, absence or number of human chromosome 8 in the sample.

49. (Once Amended) The method of claim 40, wherein the presence, absence or number of human chromosome 11 is determined by:

a[.] contacting the sample with one or more non-nucleic acid probes, wherein at least one probe has a probing nucleobase sequence, at least a portion of which is at least ninety percent homologous to the nucleobase sequences, or their complements, selected from the group consisting of:

AAC-TTC-CCA-GAA-CTA-CAC (Seq. ID No. 78); ATT-CTT-GAA-ATG-GAA-CAC (Seq. ID No. 79); CTG-TGA-TTG-CTG-ATT-TGG (Seq. ID No. 80); GTC-ATC-ACA-GGA-AAC-ATT (Seq. ID No. 81); GAA-ATT-TCC-TGT-TGA-CAG-A (Seq. ID No. 82) and GTT-TGA-AAG-CTG-AAC-TAT-G (Seq. ID No. 83); and

b[.] detecting, identifying or quantitating hybridization of the probing nucleobase sequence of the probe to a target sequence in the sample to thereby correlate the result with the presence, absence or number of human chromosome 11 in the sample.

50. (Once Amended) The method of claim 40, wherein the presence, absence or number of human chromosome 12 is determined by:

a[.] contacting the sample with one or more non-nucleic acid probes, wherein at least one probe has a probing nucleobase sequence, at least a portion of which is at least ninety percent homologous to the nucleobase sequences, or their complements, selected from the group consisting of: TCC-TGT-AAT-GTT-CGA-CAG (Seq. ID No. 84); TCA-TAG-AAC-GCT-AGA-AAG (Seq. ID No. 85); ACC-TTT-CTT-TTG-ATG-AAG-GA (Seq. ID No. 86); CAA-ATA-TCA-CAA-AAA-GAG-GG (Seq. ID No. 87);

GAG-TTG-AAT-AGA-GGC-AAC (Seq. ID No. 88); GGC-CAA-ATG-TAG-AAA-AGG (Seq. ID No. 89); GCG-TTC-AAC-TCA-AGG-TGT (Seq. ID No. 90); TGT-CCT-TTA-GAC-AGA-GCA (Seq. ID No. 91); TGA-GAC-CAA-ATG-TAC-AAA-AG (Seq. ID No. 92); GAA-TAC-TGA-GTA-AGT-TCT-TTG (Seq. ID No. 93); AAC-TGC-ACA-AAT-AGG-GTG (Seq. ID No. 94); TGG-AGA-CAC-TGT-GTT-TGT (Seq. ID No. 95) and CCA-GTT-GGA-GAT-TTC-AAT (Seq. ID No. 96); and
b[.]) detecting, identifying or quantitating hybridization of the probing nucleobase sequence of the probe to a target sequence in the sample to thereby correlate the result with the presence, absence or number of

64. (Once Amended) A kit suitable for performing an assay which detects the presence, absence or number of human chromosomes X, Y, 1, 2, 3, 6, 8, 10, 11, 12, 16, 17 or 18 in a sample, wherein said kit comprises:

a[.]) one or more non-nucleic acid probes wherein at least one probe has a probing nucleobase sequence, at least a portion of which is at least ninety percent homologous to the nucleobase sequences, or their complements, selected from the group consisting of: CTT-CAA-AGA-GGT-CCA-CGA (Seq. ID No. 1); AGG-GTT-CAA-CTG-TGT-GAC (Seq. ID No. 2); GAA-ACT-TCT-GAG-TGA-TGA (Seq. ID No. 3); CAG-TCA-TCG-CAG-AAA-ACT (Seq. ID No. 4); AGA-TTT-CAC-TGG-AAA-CGG (Seq. ID No. 5); GTT-ATG-GGA-AGG-TGA-TCC (Seq. ID No. 6); TCG-AGC-CGC-AGA-GTT-TAA (Seq. ID No. 7); CTA-TTT-AGC-GGG-CTT-GGA (Seq. ID No. 8); TAC-AAG-GGT-GTT-GCA-AAC (Seq. ID No. 9); CCA-TAT-GCA-GTT-ATA-AGT-AGG (Seq. ID No. 10); TAT-TGT-ACC-AAG-CAG-AGT-ACC (Seq. ID No. 11); GGT-ATA-TAT-AAG-ATG-ACA-CAG-GA (Seq. ID No. 12); GTT-AGT-TAT-ATT-GGG-TGA-TAT-GT (Seq. ID No. 13); TCA-CAT-AAT-AGA-CAA-CAT-AC (Seq. ID No. 14); CAG-AAG-AGA-TTG-AAC-CTT (Seq. ID No. 15); GGC-ATA-GCA-CAT-AAC-ATG (Seq. ID No. 16); AAT-CGT-CAT-CGA-ATG-AAT (Seq. ID No. 17); CAT-TGA-ACA-GAA-TTG-AAT (Seq. ID No. 18); GTT-TTC-AGG-GGA-AGA-TAT (Seq. ID No. 19); TGT-GCG-CCC-TCA-ACT-AAC (Seq. ID No. 20); GAA-GCT-TCA-TTG-GGA-TGT (Seq. ID No. 21); CCA-ATA-AAA-GCT-ACA-TAG-A (Seq. ID No. 22); GAA-AAA-GTT-TCT-GAC-ATT-GC (Seq. ID No. 23); TAG-

TTG-AAG-GGC-ACA-TCA (Seq. ID No. 24); CAC-AAA-TAA-GAT-TCT-AAG-AAT (Seq. ID No. 25); TCA-AAA-GAA-TGC-TTC-AAC-AC (Seq. ID No. 26); ATA-ATT-AGA-CCG-GAA-TCA-T (Seq. ID No. 27); GCT-GTT-TTC-TAA-AGG-AAA-G (Seq. ID No. 28); AAG-ACT-TCA-AAG-AGG-TCC (Seq. ID No. 29); TTT-GTC-AAG-AAT-TAT-AAG-AAG (Seq. ID No. 30); CAA-GAT-TGC-TTT-TAA-TGG (Seq. ID No. 31); TGT-GTA-TCA-ACT-CAC-GGA (Seq. ID No. 32); CCT-CAC-AAA-GTA-GAA-ACT (Seq. ID No. 33); GAA-AAA-GCA-GTT-ACT-GAG (Seq. ID No. 34); TAA-TAA-TTA-GAC-GGA-ATC-AT (Seq. ID No. 35); TTA-CAG-GGC-ATT-GAA-GCC (Seq. ID No. 36); CAG-TTA-TGA-AGC-AGT-CTC (Seq. ID No. 37); CAC-ACC-AGA-AAA-AGC-AGT (Seq. ID No. 38); AAG-GGT-AAA-CAC-TGT-GAG (Seq. ID No. 39); AGA-CAA-CGA-AAT-ATC-TTC-ATG (Seq. ID No. 40); CTA-GCA-GTA-TGA-GGT-CAA (Seq. ID No. 41); GCA-GAC-TTC-AGA-AAC-AGA (Seq. ID No. 42); GGC-CTC-AAA-GAC-GTT-TAA (Seq. ID No. 43); GTG-AAA-GTT-CCA-AGT-GAA (Seq. ID No. 44); GAG-TGC-TTT-GAA-GCC-TAC (Seq. ID No. 45); GAA-ACA-GCA-GAG-TTG-AAA (Seq. ID No. 46); TGC-AGA-GAT-CAC-AAC-GTG (Seq. ID No. 47); ACA-AAG-AAT-CAT-TCG-CAG (Seq. ID No. 48); AGT-GTT-AGA-AAA-CTG-CTC (Seq. ID No. 49); CTG-TTC-AGA-GTA-ACA-TGA (Seq. ID No. 50); CCG-CTT-GGA-AAT-ACT-ACA (Seq. ID No. 51); GAA-ATG-GAA-ATA-TCT-CCC-C (Seq. ID No. 52); TCT-AGG-AGG-TCC-AAT-TAT (Seq. ID No. 53); GAA-TTC-CCA-AGT-GGA-TAT (Seq. ID No. 54); CTG-TAG-GTT-TAG-ATG-AAG (Seq. ID No. 55); AAG-GAG-TGT-TTC-CCA-ACT (Seq. ID No. 56); GGC-TTC-AAG-GCG-CTC-TAA (Seq. ID No. 57); GCA-GAG-ACT-TCA-AAG-TGC (Seq. ID No. 58); CAC-ACA-CAC-GGT-GGA-CCA (Seq. ID No. 59); CAA-AGG-GAA-TGT-TCC-ATT (Seq. ID No. 60); CAC-ATA-GCA-GTG-TTT-GAG (Seq. ID No. 61); CTC-AAG-GCG-GTC-CAA-TTA (Seq. ID No. 62); GAG-TCG-AAA-TGC-ACA-CAT (Seq. ID No. 63); TAC-CAA-GAG-GAA-TGT-TGC (Seq. ID No. 64); ACG-GGA-TGC-AAT-ATA-AAA (Seq. ID No. 65); TGA-AGA-TTC-TGC-ATA-CGG (Seq. ID No. 66); AAG-GTT-TGT-ACT-GAC-AGA (Seq. ID No. 67); CTG-AAC-TAT-GGT-GAA-AAA (Seq. ID No. 68); ACT-AAC-TGT-GCT-GAA-CAT (Seq. ID No. 69); CCC-ATG-AAT-GCG-AGA-TAG (Seq. ID No. 70); AAC-TGA-ACG-CAC-AGA-TGA (Seq. ID No. 71); GGC-TAA-TCT-TTG-AAA-TTG-AAA (Seq. ID No. 72); AGG-TGG-ATA-ATT-GGC-CCT (Seq. ID No.

73); TGA-AGT-CCA-AAA-AAG-CAC (Seq. ID No. 74); CTT-AGA-CAT-GGA-AAT-ATC (Seq. ID No. 75); AAG-GGG-TCT-AAC-TAA-TCA (Seq. ID No. 76); GTA-GTT-GTT-GAG-AAT-GAT (Seq. ID No. 77); AAC-TTC-CCA-GAA-CTA-CAC (Seq. ID No. 78); ATT-CTT-GAA-ATG-GAA-CAC (Seq. ID No. 79); CTG-TGA-TTG-CTG-ATT-TGG (Seq. ID No. 80); GTC-ATC-ACA-GGA-AAC-ATT (Seq. ID No. 81); GAA-ATT-TCC-TGT-TGA-CAG-A (Seq. ID No. 82); GTT-TGA-AAG-CTG-AAC-TAT-G (Seq. ID No. 83); TCC-TGT-AAT-GTT-CGA-CAG (Seq. ID No. 84); TCA-TAG-AAC-GCT-AGA-AAG (Seq. ID No. 85); ACC-TTT-CTT-TTG-ATG-AAG-GA (Seq. ID No. 86); CAA-ATA-TCA-CAA-AAA-GAG-GG (Seq. ID No. 87); GAG-TTG-AAT-AGA-GGC-AAC (Seq. ID No. 88); GGC-CAA-ATG-TAG-AAA-AGG (Seq. ID No. 89); GCG-TTC-AAC-TCA-AGG-TGT (Seq. ID No. 90); TGT-CCT-TTA-GAC-AGA-GCA (Seq. ID No. 91); TGA-GAC-CAA-ATG-TAC-AAA-AG (Seq. ID No. 92); GAA-TAC-TGA-GTA-AGT-TCT-TTG (Seq. ID No. 93); AAC-TGC-ACA-AAT-AGG-GTG (Seq. ID No. 94); TGG-AGA-CAC-TGT-GTT-TGT (Seq. ID No. 95); CCA-GTT-GGA-GAT-TTC-AAT (Seq. ID No. 96); GAA-GCC-TGC-CAG-TGG-ATA (Seq. ID No. 97); TAC-AGC-ATT-CTG-GAA-ACC (Seq. ID No. 98); CCA-GAC-ACT-GCG-TAG-TGA (Seq. ID No. 99); ATA-TAA-TGC-TAG-AGG-GAG (Seq. ID No. 100); AAA-AAC-AAG-ACA-AAC-TCG (Seq. ID No. 101); ATT-TCA-GCT-GAC-TAA-ACA (Seq. ID No. 102); AAC-GAA-TTA-TGG-TCA-CAT (Seq. ID No. 103); GGT-GAC-GAC-TGA-GTT-TAA (Seq. ID No. 104); TTT-GGA-CCA-CTC-TGT-GGC (Seq. ID No. 105); AAC-GGG-ATA-ACT-GCA-CCT (Seq. ID No. 106); TTT-GTG-GTT-TGT-GGT-GGA (Seq. ID No. 107); AGG-GAA-TAG-CTT-CAT-AGA (Seq. ID No. 108); ATC-ACG-AAG-AAG-GTT-CTG (Seq. ID No. 109); CCG-AAG-ATG-TCT-TTG-GAA (Seq. ID No. 110); AAA-GAG-GTC-TAC-ATG-TCC (Seq. ID No. 111); TTC-CCG-TAA-CAA-CTA-TGC (Seq. ID No. 112); TCC-CGT-AAC-AAC-TAG-GCA (Seq. ID No. 113); AAA-AGG-AGT-GAT-CCA-ACC (Seq. ID No. 114); TCC-CTT-TGG-TAG-AGC-AGG (Seq. ID No. 115); ATT-TGA-GAT-GTG-TGT-ACT-CA (Seq. ID No. 116); GCA-CTT-ACC-GGC-CTA-AG (Seq. ID No. 117) and CTC-AGA-AAC-TTA-CTC-GTG (Seq. ID No. 118); and b[.] other reagents or compositions necessary to perform the assay. --

No new matter has been introduced by this amendment.

IV. RESPONSE TO THE RESTRICTION/ELECTION REQUIREMENT

(i) *Argument*

Applicants respectfully submit that it is unclear from the present Office Action whether the Examiner is imposing a restriction requirement or an election requirement. It is unclear because in certain paragraphs of the argument, the Examiner refers to 35 U.S.C. § 121 and 37 C.F.R. § 1.141 in connection with asserting that more than one invention is described by the claims whilst in other portions of the argument, the Examiner refers to distinct species of a genus. It is respectfully submitted that there is a substantial difference between an election requirement and a restriction requirement; the former not requiring the cancellation of claims whilst the latter does. For the purposes of this response, Applicant will assume that the present Office Action pertains to a restriction requirement despite there being no request to cancel claims.

Applicants respectfully traverse the election/restriction requirement. Reasoning specific to each claim will be set forth below. However, in general Applicant takes the position that any restriction requirement is not proper because the claims are generic in nature and therefore, it is not proper to impose a restriction requirement. If the Examiner seeks an election requirement, Applicant reiterates that the claims are generic in nature but will elect a species as set forth below for purposes of examination with the expectation that if the species is allowable, all claims will be allowable as filed, or amended herein or during further prosecution.

Regarding independent claim 1 and dependent claim 2, the claims are directed to a non-nucleic acid probe wherein the exact chemical composition of the probe is defined in Markush language. The claims are not directed to particular nucleobase sequences as the Examiner apparently believes. Such generic claim language is therefore not properly subject to a restriction or election requirement.

Regarding independent claim 10, and its dependent claims 11-12, these claims are directed to a probe set comprising at least 13 non-nucleic acid probes. The claims are not directed to particular nucleobase sequences as the Examiner apparently believes. Such generic claim language is not properly subject to an election or restriction requirement.

Regarding independent claims 29, 31, 33, and 34, these claims pertain to species of the generic claim 10, and its dependent claims. Accordingly, the claims are not properly subject to an election or restriction requirement.

Regarding independent claim 38 and its dependent claim 39, these claims pertain to a generic method for detecting, identifying or quantitating one or more of certain

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b*

human chromosomes in a sample. Accordingly, the claims are not properly subject to an election or restriction requirement.

Regarding independent claim 40, and its dependent claims 45, 47, 49, 50 and 54-56, these claims pertain to species of the generic method claim 38. Accordingly, the claims are not properly subject to an election or restriction requirement.

Regarding independent claim 64, and its dependent claims 65-66, these claims pertain to a generic kit. Accordingly, the claims are not properly subject to an election or restriction requirement.

Regarding independent claim 78 and its dependent claims 79-81, these claims pertain to a generic multiplex assay method. Accordingly, the claims are not properly subject to an election or restriction requirement.

(ii) *Election*

Because Applicants are forced to make an election of the invention as advised by paragraph 5 (page 6) of the present Office Action, notwithstanding Applicant's traversal of the present restriction/election requirement, Applicant provisionally elect human chromosome X and Seq. Id. Nos. 1-9. Applicant's nevertheless reiterate their traversal of this requirement.

V. SUMMARY

It is believed that this response addresses all rejections set forth in the present Office Action and the application is in ready condition for allowance. In consideration of the preceding amendments and remarks, Applicants hereby respectfully request reconsideration of all pending claims (as amended), the withdrawal of all rejections set forth in the present Office Action and issue of a Notice of Allowance by The Office.

VI. INTERVIEW

If the Examiner believes a telephonic or personal interview would advance the prosecution of the subject application, the Examiner is invited to contact attorney Gildea during business hours at the telephone or facsimile numbers listed below.

VII. ENCLOSURES

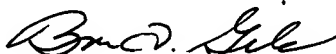
Enclosed herewith please find:

- 1) A petition, under 37 C.F.R. § 1.136 (a), for an automatic three month extension of time to respond to the present Office Action and authorization to charge the appropriate fee therefore.

- 2) A petition under 37 C.F.R. § 1.84(a)(2) and (b)(2) for permission to submit color drawings and authorization to charge the appropriate fee therefore.
- 3) 2 Additional Sets of Formal Color Drawings.

VIII. FEES

A petition for an automatic three month extension of time under 37 C.F.R. § 1.136 (a) and fee paid pursuant to 37 C.F.R. § 1.17 has been included with the papers accompanying this response. A petition under 37 C.F.R. § 1.84(a)(2) and (b)(2) as fee pursuant to 37 C.F.R. § 1.17(h) has also been included with the paper accompanying this response. No additional fees are believed due The Office for consideration of this paper. If however, The Office determines that any other fee is due, authorization is hereby granted to charge any required fee associated with the filing of this paper to Deposit Account 02-3240.

 1/10/02
Brian D. Gildea, Reg. No. 39,995

IX. CORRESPONDENCE/CUSTOMER NUMBER

Please send all correspondence pertaining to this document to:

Boston Probes, Inc.
Attn: Brian D. Gildea, Esq.
15 DeAngelo Drive
Bedford, MA 01730

Telephone: 781-271-1100 ext. 224
Fax: 781-276-4931

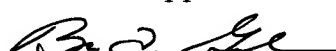
IF NOT ALREADY DONE, PLEASE MATCH THIS CASE WITH CUSTOMER
NUMBER 23544



23544

[Insert Customer Number **Bar Code**]
PATENT TRADEMARK OFFICE

Respectfully submitted
on behalf of Applicants,

 1/10/02
Brian D. Gildea, Esq.
Reg. No. 39,995